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### **REMARKS**

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

### **Status of Claims**

Claims 1-32 are pending in the application.

Claims 1-32 have been rejected.

Claims 1, 9, 16, 19, 25 and 28 have been amended.

Claims 4 and 31 have been cancelled without prejudice or disclaimer. In making this cancellation without prejudice, Applicant reserves all rights in these claims to file divisional and/or continuation patent applications.

### **CLAIM REJECTIONS**

#### **35 U.S.C. § 112 Rejections**

In the Office action, the Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for allegedly containing subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention, in reciting "separately selecting a coding mode" in claim 1.

Applicant respectfully disagrees. As claim 1 recites: "adaptively and separately selecting a coding mode of each orthogonal frequency division multiplexing sub-carrier symbols of a data stream in an orthogonal frequency division multiplexing channel according to a received channel state information that

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relates to the orthogonal frequency division multiplexing sub-carrier". That is, the selection of a coding mode of each orthogonal frequency division multiplexing sub-carrier symbols of a data stream is done "according to a received channel state information that relates to the orthogonal frequency division multiplexing sub-carrier."

Applicant respectfully asserts that these arguments render claim 1 proper under 35 USC 112 and request that the rejections be withdrawn.

### **35 U.S.C. § 103 Rejections**

In the Office action, the Examiner rejected claims 1, 4, 6, 7, 9, 11, 13, 16, 17, 25, 26, 28 and 31 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein et al. (US 6,131,016, the '016 patent) in view of Dabak et al. (US 2004/0071118, the '118 application).

Applicant respectfully traverse the rejection of claims 1, 4, 6, 7, 9, 11, 13, 16, 17, 25, 26, 28 and 31 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein et al. in view of Dabak et al.

Regarding independent claim 1, it was amended to include the limitations of claim 4. Applicant asserts that neither Greenstein nor Dabak, alone or in combination, teach or suggest all the features of claim 1, as amended and in particular: "adaptively grouping receivers according to a desired coding mode received with the received channel state information". The Examiner contended, with respect to claim 4 (now included in claim 1) that "[in view of Greenstein] it would be inherent to group all the receivers if there is only a single coding mode". Applicant respectfully disagrees. Applicant would like to point out that it is improper for the Office action to infer that a cited document inherently teaches a claim feature when such an interpretation is not supported by the teachings of the document.

Referring to the rejections to independent claim 1, Applicant respectfully asserts that persons of ordinary skill in the art are aware that grouping of receivers should not necessarily be done or may be done according to a desired coding mode received from data source other than the received channel state information. Furthermore, when relying upon a theory of inherency, the Office action "must

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provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art." M.P.E.P. §2112 (citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). The test of inherency is not satisfied by what a reference "may" teach. *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corp.*, 32 U.S.P.Q.2d 1496, 1503 (Fed. Cir. 1994) (citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 U.S.P.Q.2d 1746, 1749-50 (Fed. Cir. 1991)). Rather, evidence of inherency "**must make clear** that the missing descriptive matter is necessarily present in the thing described in the reference, **and** that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d at 1268-69, 20 U.S.P.Q.2d at 1749 (emphasis added). The Office action has not met this burden.

An obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Since the Greenstein reference and the Dabak reference, alone or in combination, do not teach or suggest all the elements of any of independent claim 1 and since inherency type rejection is deemed improper, the Examiner fails to establish a prima facie showing that the first reference or the second reference, alone or in combination, teach or suggest every feature of claim 1, as amended. Accordingly, Applicant requests that the Examiner withdraw the rejection of claim 1, as amended.

Regarding independent claims 9, 16, 25 and 28, as amended, the arguments made above with respect to claim 1 are applicable also here, *mutatis mutandis*. Accordingly, independent claims 9, 16, 25 and 28 are similarly deemed allowable. Accordingly, Applicant respectfully asserts that amended independent claims 1, 9, 16, 25 and 28 are allowable. Claims 4, 6 and 7; 11, and 13; 17; 26; and 31 depend from, directly or indirectly, claims 1, 9, 16, 25 and 28, and therefore include all the limitations of those claims. Therefore, Applicant respectfully asserts that claims 4, 6 and 7; 11, and 13; 17; 26; and 31 are likewise allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections to amended independent claims 1, 9, 16, 25 and 28 and to claims 4, 6 and 7; 11, and 13; 17; 26; and 31 dependent thereon.

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In the Office action, the Examiner rejected claims 2, 3, 5, 8, 12, 14, 15, 18, 21, 23, 24, 27, 29, 30 and 32 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein et al. and Dabak et al. in view of the background of the instant application.

Applicants respectfully traverse the rejection of claims 2, 3, 5, 8, 12, 14, 15, 18, 21, 23, 24, 27, 29, 30 and 32 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein and Dabak in view of the background of the instant application.

Rejected claims 2, 3, 5 and 8; 12, 14 and 15; 18, 21, 23 and 24; 27 and 29, 30 and 32 depend from independent claims 1, 9, 16, 25 and 28. As to independent claims 1, 9, 16, 25 and 28 as amended, they are deemed allowable over Greenstein and Dabak as discussed above. Claims 2, 3, 5 and 8; 12, 14 and 15; 18, 21, 23 and 24; 27 and 29, 30 and 32 depend from, directly or indirectly, claims 1, 9, 16, 25 and 28, and therefore include all the limitations of those claims. Therefore, Applicant respectfully asserts that claims 2, 3, 5 and 8; 12, 14 and 15; 18, 21, 23 and 24; 27 and 29, 30 and 32 are likewise allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections to claims 2, 3, 5 and 8; 12, 14 and 15; 18, 21, 23 and 24; 27 and 29, 30 and 32.

In the Office action, the Examiner rejected claims 10 and 20 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein et al. and Dabak et al. in view of Wu et al. (US 6,985,434, the '434 patent).

Applicant respectfully traverses the rejection of claims 10 and 20 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein et al. and Dabak et al. in view of Wu et al.

The allowability of independent claims 1 and 19, as amended, over Greenstein and Dabak was discussed above. Wu fails to cure the deficiency of Greenstein and Dabak at least with respect to "adaptively grouping receivers according to a desired coding mode received with the received channel state information", as recited in claim 1, as amended. Same arguments apply to independent claim 19, as amended, *mutatis mutandis*. Accordingly, independent claims 1 and 19 are deemed allowable. Claims 10 and 20 depend from, directly or indirectly, independent claims 1 and 19, and therefore include all the limitations of those claims. Therefore, Applicant respectfully asserts that claims 10 and 20 are

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likewise allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections to claims 10 and 20.

In the Office action, the Examiner rejected claims 19 and 22 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein et al. in view of Dabak et al.

Applicants respectfully traverse the rejection of claims 19 and 22 under 35 U.S.C. § 103(a), as being unpatentable over Greenstein in view of Dabak.

The allowability of independent claim 19 over Greenstein as modified by Dabak has been discussed above. Accordingly, independent claim 19, as amended, is deemed allowable over the cited art. Claim 22 depends from claim 19 and therefore includes all the limitations of claim 19. Therefore, Applicant asserts that claim 22 is likewise allowable. Accordingly, applicant requests that the Examiner withdraw the rejection of claims 19 and 22.

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### CONCLUSION

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



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